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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/463,525	01/26/2000	JEAN-MARIE BERNARD	RN97085	6433

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EXAMINER

SERGEANT, RABON A

ART UNIT

PAPER NUMBER

1711

DATE MAILED: 06/04/2002

11

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
09/463,525

Applicant(s)  
Bernard

Examiner  
Rabon Sergent

Art Unit  
1711



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Mar 11, 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 27, 29, 30, 32, 37-40, 43, 45-50, and 52-55 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 27, 29, 30, 32, 37-40, 43, 45-50, and 52-55 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 6) ☐ Other:

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1. Claims 37-40 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The language, "said masking agent containing a carboxylic acid function", lacks antecedent basis. Despite applicant's response, the claims have not been canceled.

2. Claim 43 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The language, "said carboxylic acid function is directly onto an aromatic ring ...", is ambiguous. It is not clearly understood what is meant by the language.

3. Claims 27, 29, 30, 32, 37-40, 43, 45-50, and 52-55 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicant's specification is confusing for the following two reasons. Firstly, within the claims, applicant's ratio of carboxylic functions to isocyanate groups is based on all isocyanate groups, whether they be free, masked, or reacted with the carboxylic function containing compound; however, within the specification the ratio is dependent only on the masked isocyanate groups (see line 25 of page 15). Furthermore, it is unclear where support exists for the lower limit of 5%. Secondly, according to parts of the specification, the claims, and applicant's arguments, the carboxylic function is either an acid or a

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salt; however, the definition of Z within formula I on page 18 indicates that the acid function is the least preferred. Clarification of these points is required.

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness

rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 27, 29, 30, 32, 37-40, 43, 45-50, and 53-55 are rejected under 35 U.S.C. 102(b) as being anticipated by EP 56167.

The reference discloses the combined use of carboxylic function containing masking agents and conventional masking agents to block polyisocyanates, which are to be used in powder coating compositions. See pages 9-11 of the translation. Despite applicant's arguments, the claimed ratio of carboxylic function to isocyanate group is clearly embodied by the formula on page 9 and the disclosed reactant species. For example, the most basic interpretation of the formula and species leads one to a ratio of 1:2, which is within the claimed range. Further, the examiner finds no difference in the way the respective blocked polyisocyanate compositions are produced.

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6. Claim 52 is rejected under 35 U.S.C. 103(a) as being unpatentable over EP 56167 in view of Witte et al. ('646) or Kurek et al. ('106).

As aforementioned, EP 56167 discloses the combined use of carboxylic function containing masking agents and conventional masking agents to block polyisocyanates, which are to be used in powder coating compositions. See pages 9-11 of the translation. Though the reference discloses several types of conventional blocking agents, the reference fails to specifically recite the use of triazole. However, the use of triazole as a blocking agent for polyisocyanates to be used within powder coating compositions was known at the time of invention. This position is supported by the teachings of the secondary references. See column 2, line 41 within Witte et al. See abstract of Kurek et al. Therefore, it would have been obvious to employ triazole as a blocking agent in accordance with the teachings of the primary reference, so as to arrive at the instant invention.

Any inquiry concerning this communication should be directed to R. Sergent at telephone number (703) 308-2982.

  
RABON SERGENT  
PRIMARY EXAMINER

R. Sergent

June 1, 2002